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In re Application of :
NOGAMI et al. :
Application No. 10/690,811 : DECISION ON PETITION
Filed: 23 October 2003 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 24-009-TB :

This is a decision on Petitioner's request to confirm acceptance of earlier claim for domestic priority under 35 U.S.C. 120 and 365(c) and in the alternative, the petition under 37 CFR 1.78(a)(3), filed 06 May 2008, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed PCT Application No. PCT/JP02/03920 filed on 19 April 2002.

Applicant requests confirmation, that his claim for domestic priority under 35 U.S.C. 120 and 365(c) made at the time of filing the present application, was accepted. On 23 October 2003, Applicant indicated on the Form/SB/05 that the instant application is a "continuation" of "prior application PCT/JP02/03920". This indication was not a proper claim for domestic priority because the claim was not made in the first sentence of the specification or in an Application Data Sheet (ADS) as required under 37 CFR 1.78(a)(2)(iii). Because the benefit claim on the Form/SB/05 was not picked up on the first official filing receipt and Applicant did not amend the first line of the specification or file an ADS within the four month time period of the filing of the present application to include a proper claim, the filing of a petition under 37 CFR 1.78(a)(3) is necessary. Such petition is hereby **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

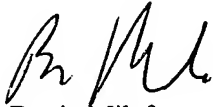
- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question

whether the delay was unintentional.

On 30 October 2007, Applicant furnished an amendment to the first sentence of the specification; however, this amendment was not proper as it incorporates by reference the prior applications. The petition filed on 05 May 2008, however, complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed international application has been included in the application data sheet as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains a proper statement of unintentional delay. Accordingly, having found that the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed PCT application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this instant application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met.

Any inquiries concerning this decision may be directed to Cynthia M. Kratz at (571) 272-3286. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.



Boris Milef

Legal Examiner

Office of PCT Legal Administration